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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Credit Suisse First Boston Corporation

Serial No. 78194343

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103 (Michael Hamilton, Managing Attorney).

Before Chapman, Rogers, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 13, 2002, Credit Suisse First Boston
Corporation (applicant) applied to register the mark
FUNDCENTRAL (in typed form) on the Principal Register for
"financial services, namely providing reports and financial
information regarding financial transactions, investments,
investors, and financial markets" in Class 36.¹

¹ Serial No. 78194343. The application is based on applicant's
assertion of a bona fide intention to use the mark in commerce.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark MUTUAL FUNDS CENTRAL (in typed form) for "computer services, namely, providing an on-line magazine in the field of information technology mutual funds" in Class 42.²

The examining attorney's position (Brief at 4) is that the "the two marks are essentially 'synonymous wording' + 'CENTRAL.'"³ Regarding the services, the examining attorney argues (Brief at 6) that by "Applicant's own admission, the services are offered in an online format. Furthermore, they could even take on the appearance of an online magazine that deals with information technology mutual funds." As a result, the examining attorney submits that there is a likelihood of confusion.

Applicant's position (Brief at 7) is that the cited mark "is a highly suggestive weak mark, that the word 'CENTRAL' should not enjoy broad protection for financial services, and that the overall differences between

² Registration No. 2,509,574, issued November 20, 2001. The registration contains a disclaimer of the term "Mutual Funds."

³ The examining attorney asks that we take judicial notice of on online dictionary definition of "mutual fund" in his appeal brief. We do not normally take judicial notice of on-line dictionaries that are submitted for the first time on appeal. In re Total Quality Group, Inc., 51 USPQ2d 1474, 1476 (TTAB 1999). Therefore, we will not consider the on-line definition submitted with the examining attorney's brief.

Appellant's mark and the cited mark render confusion unlikely." In addition, applicant argues (Brief at 11-12) that its service "is a highly sophisticated information portal" and that "even if the same consumers encountered both marks, such consumers are highly sophisticated and instantly would understand" that the services "do not originate from the same source."

Inasmuch as this case involves a question of likelihood of confusion, we must analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

One factor that is often critical in a likelihood of confusion case is the similarity or dissimilarity of the goods and/or services. Applicant's services involve

"providing reports and financial information regarding financial transactions, investments, investors, and financial markets." Registrant's services are "providing an on-line magazine in the field of information technology mutual funds." Registrant's services are limited to the field of information technology mutual funds. Applicant's services are more general and applicant's identification of services specifically includes "providing reports and financial information regarding ... investments ... and financial markets." These services could include providing reports and financial information on investments in information technology mutual funds and on financial markets concerning information technology mutual funds. We note that applicant admits that its services are in fact provided online. See Brief at 10 ("Appellant's FUNDCENTRAL service is an investor reporting system offered via a password-protected website"). Therefore, the services are very closely related, if not overlapping in part.

Applicant argues (Brief at 11) that its service "is a highly sophisticated information portal regarding financial investments owned by the client..." that "provides detailed account valuations, including cash flow and performance summaries, account transaction details, commitments by geographic concentration and commitments by industry..." and

it "is restricted-access and is used by pension fund managers, investment officers, accountants and wealthy individuals." These restrictions or limitations, however, do not appear in applicant's identification of services, and, therefore, they do not aid applicant in distinguishing its services from registrant's. "The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed." Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods [or services]").

Another important factor in likelihood of confusion cases concerns the similarities and dissimilarities of the marks in the application and registration(s). Applicant's mark is FUNDCENTRAL while registrant's mark consists of the words MUTUAL FUNDS CENTRAL. There are three differences

between the marks. First, applicant deletes registrant's word "Mutual." Second, registrant uses the plural form of "Fund." Third, applicant omits the normal space between the words in its mark.

Initially, we note that the absence of a space is not very significant. Stockpot, Inc. v. Stock Pot Restaurant, Inc., 220 USPQ 52, 54 (TTAB 1983), aff'd, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical"); In re Best Western Family Steak House, Inc., 222 USPQ 827, 827 (TTAB 1984) ("There can be little doubt that the marks [BEEFMASTER and BEEF MASTER] are practically identical"); Seaguard Corp. v. Seaward International, Inc., 223 USPQ 48, 51 (TTAB 1984) (SEA GUARD and SEAGUARD are "essentially identical").⁴ Nor is the difference between the singular and plural form of the word "Fund" particularly distinguishing. Wilson v. Delauney, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ("It is evident that there is no

⁴ Both applicant's and registrant's services involve the Internet where the spelling of the same words with or without spaces is common when the words are used in a web address and in the text of an article.

material difference, in a trademark sense, between the singular and plural forms of the word "Zombie" and they will therefore be regarded here as the same mark").

Regarding the deletion of the word "Mutual," the remaining word "Fund(s)" would have, at least in part, a similar connotation. Indeed, a mutual fund is a type of fund. While we did not take judicial notice of the examining attorney's online definition, we do take judicial notice of the following entry.⁵ "Mutual Fund: a company that invests its clients' funds in other companies, equities, or securities... In open-end funds, the investor is not generally committed to hold the stock for a specified period. Closed-end funds are sometimes sold on a contractual basis requiring a minimum investment and holdings kept for a minimum period." Webster's New World Encyclopedia 776 (1992). In effect, the term "Mutual Fund" or "Fund" can have overlapping meanings inasmuch as a mutual fund can be referred to as a fund. Thus, it is difficult to conceive of the difference between "Mutual Funds" and "Fund" leading to a lack of confusion when the only other term in the marks is the shared term "Central."

⁵ University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We add that registrant has disclaimed the descriptive words "Mutual Funds" in its mark and the term "Fund" in applicant's mark would likewise have a descriptive connotation. Thus, the term "Mutual Funds" and the "Fund-" portion of applicant's mark are less likely to be used by consumers to distinguish the marks. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985) ("Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'").

Our analysis of the individual differences in the marks is not an attempt to avoid our duty to analyze the marks in their entirety. The Federal Circuit has explained that "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant argues (Brief at 7-8) that four third-party registrations⁶ owned by three different entities "provide compelling evidence of what most consumers would recognize from experience; namely that the term CENTRAL is widely used in the financial industry to suggest a type of financial center and that consumers can expect different CENTRAL formative marks in the financial services arena to emanate from unrelated sources." The four third-party registrations are: BONDCENTRAL for "online financial management and investment management services" (No. 2,389,428); BANK CENTRAL for "telephonic banking services" (No. 1,909,447); and two registrations (Nos. 2,482,959 and 2,478,368) owned by the same party for MONEYCENTRAL for, respectively, entertainment in the nature of ongoing radio programs in the field of news and financial and investment information, and providing on-line investment management portfolio tools and information over computer networks in the field of finance.

We have several problems with applicant's arguments. First, the cited registration is clearly the most relevant registration because it contains the common words "Fund(s) Central." Second, as we indicated earlier, the services

⁶ A fifth (No. 2,101,443) for the mark STOCKCENTRAL was cancelled.

are, if not overlapping, closely related. The services in the third-party registrations for radio programs and telephonic banking services are much less closely related. Third, registrations are not evidence that the referenced marks are in use. In re Mitsubishi Jidosha Kogyo Kabushiki Kaisha, 19 USPQ2d 1633, 1634 (TTAB 1991) ("We note that applicant has made of record certain third-party registrations for marks comprising or containing the word SIGMA, but such registrations do not prove the marks are in use and that consumers are familiar with them"). Fourth, while third-party registrations may be used to demonstrate that a portion of a mark is suggestive or descriptive, they cannot be used to justify the registration of another confusingly similar mark. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). In this case, the few registrations of record hardly establish that the registered mark is so highly suggestive that it should be entitled to a narrow scope of protection.

When we compare the marks in their entirety, similarities in sound, appearance, meaning, and commercial impression of FUNDCENTRAL and MUTUAL FUNDS CENTRAL outweigh their differences. The marks look and sound similar to the extent that the common part of both marks "Fund[s] Central" is virtually identical. See Wella Corp. v. California

Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products); In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("With respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAR is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark." The marks JOSE GASPAR GOLD and GASPAR'S ALE were determined to be similar). The particular meanings and overall commercial impressions of both marks suggest a central location for information about mutual funds.

We also add that, in regard to purchasers and channels of trade, there are no limits in the identifications of services so we cannot assume limitations. While applicant argues that its services are directed to professional fund managers and wealthy individuals, there is no reason, based on the identification of services, to exclude other potential purchasers from our analysis, including investors of more modest means. See Knorr-Nahrmittel Aktiengesellschaft v. Havland International, Inc., 206 USPQ 827, 835 (TTAB 1980):

In the absence of any limitation as to the cheese product listed in the application as to type, trade channels, or classes of purchasers, it may be presumed for our purposes that applicant sells all types of cheese in all types of containers through all the normal outlets for such goods including institutional and retail outlets for use by both institutional users such as restaurants, hotels, hospitals and the like and by the general consuming public.

Similarly here, we must assume that the services of both applicant and registrant are provided through all customary channels of trade for such services and that they could be encountered by fund managers and wealthy and non-wealthy individuals seeking reports and the like on information technology investments. Therefore, there is at least an overlap in the channels of trade and classes of prospective purchasers.

Applicant also argues that even if the same purchasers encountered both marks, they are highly sophisticated and instantly will understand that the services do not originate from the same source. First, we cannot agree with applicant's basic premise that only highly sophisticated purchasers could encounter both marks. As identified, both marks would likely be encountered by a wide range of purchasers including ordinary investors who would not be particularly sophisticated. Second, services can be considered to be related if even sophisticated purchasers are likely to believe that there is an

association between the source of applicant's and registrant's services. In this case, even if sophisticated purchasers thought the services had different sources, they may believe that there is an association, relationship, or sponsorship arrangement between the sources of the very closely related services identified by the very similar marks MUTUAL FUNDS CENTRAL and FUNDCENTRAL.

Therefore, we conclude that applicant's mark, when used in connection with its identified services, would be likely to cause confusion with registrant's mark used in connection with its identified services.

Decision: The examining attorney's refusal to register under Section 2(d) of the Trademark Act is affirmed.